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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,443	01/31/2005	Robert Lance Cook	25791.111.03	3853

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HAYNES AND BOONE, LLP
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DALLAS, TX 75202-3789

EXAMINER

BOMAR, THOMAS S

ART UNIT	PAPER NUMBER
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3672

MAIL DATE	DELIVERY MODE
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07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,443

Applicant(s)

COOK, ROBERT LANCE

Examiner

Shane Bomar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/35368 to Lohbeck et al in view of US 4,573,540 to Dellinger et al.

Lohbeck teaches a method and system of forming a wellbore casing within a borehole that traverses a subterranean formation, comprising: positioning a first wellbore casing 8 within and coupling the first wellbore casing to the borehole; positioning a second wellbore casing 9 within the borehole that overlaps with and is coupled to the first wellbore casing; extending the length of the borehole; and positioning a third wellbore casing 10 within the borehole that overlaps with and is coupled to the second wellbore casing (see Fig. 1 and pages 6-7). The method and system also includes radially expanding and plastically deforming the overlapping portions of the first and second wellbore casings, and radially expanding and plastically deforming the portion of the second wellbore casing that does not overlap with the first wellbore casing. The inside diameters of all the casing sections are equal and constant (see Fig. 1). However, it is not specifically taught that the method or system includes positioning a tubular liner within the borehole that overlaps with and is coupled to at least a portion of the second wellbore casing, or decoupling of the tubular liner from the second wellbore casing and removing the tubular liner from the borehole.

Dellinger et al teach a method and system of forming a wellbore casing 13 within a borehole, wherein a liner 31 is positioned within the borehole that overlaps with and is coupled to at least a portion of the casing (see the Figure and col. 4, lines 20-35). It is further taught that the liner is decoupled from the casing and removed from the borehole (see col. 4, lines 41-47). It would have been obvious to one of ordinary skill in the art, having the teachings of Lohbeck et al and Dellinger et al before him at the time the invention was made, to modify the method and system taught by Lohbeck et al to include the liner insertion and removal steps of Dellinger et al. One would have been motivated to make such a combination because the casing would be fully protected from the drill bit until the drilling is complete (see col. 4, lines 49-52 of Dellinger et al).

Response to Arguments

3. Applicant's arguments filed April 2, 2007 have been fully considered but they are not persuasive. The Applicant has appeared to misinterpret the reasoning and motivation for combining the Lohbeck and Dellinger references. This appears to be the case because the Applicant states that Lohbeck's liner is installed only after the borehole is completely drilled and cases, and the Applicant states that the Examiner concedes that Lohbeck, among other things, fails to teach or suggest extending, or means for extending, the length of the borehole. However, the Examiner did not rely on the teaching of a production liner of Lohbeck, which the Examiner must take as the production tubing of Figure 2. The Examiner relied upon the disclosure of Figure 1 wherein one casing is installed, the length of the borehole is extended, and then another section of casing is installed. The Examiner then stated that the positioning of a liner and the

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subsequent decoupling of the liner was deficient in the Lohbeck disclosure. Wherein the Examiner relied upon Dellinger to provide the liner limitation, wherein the liner is subsequently decoupled and removed, the motivation for combination being that the interior of the casing is protected by the liner during drilling. The Applicant also argues that Lohbeck is for vertical drilling while Dellinger is related to directional drilling. However, the Examiner does not see Lohbeck as being limited to just vertical drilling only because the drawings show vertical holes. It is notoriously known that the drawings are used just to show exemplary aspects of the invention, and other modifications known to those of ordinary skill in the art can be made. For instance it is notoriously known to drill and case boreholes so that a monodiameter borehole is achieved, whether the orientation of the hole is vertical or deviated. US 7,225,879 provides an example of this notoriety in column 17 line 60 through column 18, line 2.

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

July 22, 2007

tsb 